

REMARKS

The present application has been reviewed in light of the Office Action dated October 8, 2003. Claims 29-46 are presented for examination, of which Claims 29, 34, 39, and 46 are in independent form. Claims 29, 33, 34, 36-39, 41, and 43-46 have been amended as to formal matters and/or to define Applicant's invention more clearly. Favorable reconsideration is requested.

The Office Action states that Claims 29-46 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No. 5,765,170 (Morikawa) in view of U.S. Patent No. 6,453,327 (Nielsen). Applicant respectfully traverses the rejections and submits that independent Claims 29, 34, 39, and 46, together with the claims dependent therefrom, are patentably distinct from the cited prior art for at least the following reasons.

An aspect of the present invention set forth in Claim 29 is directed to a communication device for receiving an e-mail stored in an e-mail server. The device includes communication means, memory means, acquisition means, determination means, and warning means. The communication means transmits an e-mail transmission request to the e-mail server and receives the e-mail transmitted from the e-mail server in response to the transmission request. The memory means stores the e-mail received from the e-mail server.

Before the communication means receives the e-mail from the e-mail server, the acquisition means acquires size information of the e-mail. Based on the acquired size information and an available storage capacity of the memory means, the determination means determines whether the storage capacity of the memory means is sufficient to store all data

included in the e-mail. If it is determined that the available storage capacity of the memory means is sufficient to store all the data included in the e-mail, the e-mail server transmits the e-mail entirely, otherwise the e-mail server transmits only header data of the e-mail. If it is determined that the available storage capacity of the memory means is not sufficient to store all the data included in the e-mail, the warning means visually outputs warning information indicating that the e-mail stored in the e-mail server cannot be entirely received.

Morikawa relates to an electronic mail processing system, in which folders are used for storing received electronic mail. A management device of the system classifies a data file written in the received electronic mail and selects a folder for storing the data file. (See the abstract and column 2, lines 33-41.)

Nielsen relates to a mail system with a junk e-mail screening feature for identifying and discarding junk e-mail. A subset of the members of a trusted group of recipients determines for the rest of the trusted group whether an e-mail should be considered junk. That is, if a sufficient number of the trusted group of recipients classifies the e-mail as junk, then the e-mail is automatically removed (deleted) from the mail system so that the other members of the trusted group who have not yet viewed the e-mail are not annoyed by it. (See column 6, lines 53-67.)

Applicant submits that a combination of Morikawa and Nielsen, assuming such combination would even be permissible, would fail to teach or suggest a communication device for receiving an e-mail stored in an e-mail server, wherein the device includes "acquisition means for acquiring, before said communication means receives the e-mail from the e-mail server, size

information of the e-mail," and "determination means for determining, based on the size information acquired by said acquisition means and an available storage capacity of said memory means, whether the storage capacity of said memory means is sufficient to store all data included in the e-mail, wherein, if it is determined that the available storage capacity of said memory means is sufficient to store all the data included in the e-mail, the e-mail server transmits the e-mail entirely, otherwise the e-mail server transmits only header data of the e-mail," and "warning means for, if said determination means determines that the available storage capacity of said memory means is not sufficient to store all the data included in the e-mail, visually outputting warning information indicating that the e-mail stored in the e-mail server cannot be entirely received," as recited in Claim 29.

Neither Morikawa nor Nielsen is understood to disclose or suggest making any determination regarding reception of an e-mail based on the size of the e-mail. Rather, Morikawa merely calculates the length of an e-mail M and an attachment AF, and stores this information in an envelop part ME. Morikawa is silent as to how this size information is used, if at all, and certainly makes no suggestion about using this size information to make a determination regarding reception of an e-mail.

The Office Action, in section 4 on pages 5-6, alleges that Morikawa "discloses creating an email (using the electronic mail facility) based on the size (length) of the email and the attachments AF as attribute information . . ." Applicant respectfully traverses such a characterization of Morikawa, and submits that Morikawa at column 7, lines 22-37, clearly states that an e-mail *first* is created by a mail creating function; *then* contents of the e-mail are created

by an editing process; and *then*, after receipt of an instruction to terminate editing, a length of the attachment file AF and the mail M is calculated. That is, the Morikawa system does not calculate the size of the e-mail until *after* the e-mail is created.

It appears that there is an attempt in the Office Action to associate the size of the mail M and the attachment AF with a receiving function of the Morikawa system. Applicant respectfully submits that there is no basis for such an association. In fact, nothing has been found in Morikawa that discusses storing the mail M and/or the attachment AF based on size. The receiving function of the Morikawa system merely stores a heading file HF in a message folder FM (see column 8, lines 3-5), and attachments AF are stored in folders that either are specified on the transmitting side or ascertained by a utility 5 from reading file attribute information Att and searching a folder table 7 (see column 7, lines 44-47, and column 8, lines 33-39).

Further, Applicants submit that both Morikawa and Nielsen are silent regarding receiving all data included in an e-mail or receiving only a header of the e-mail, depending on whether an available storage capacity of memory means is sufficient to store all the data included in the e-mail. Furthermore, nothing in the cited art is seen to show or suggest that warning information is outputted if it is determined that the available storage capacity of the memory means is not sufficient to store all of the data included in the e-mail. (Support for this feature may be found in the specification at page 28, lines 10-25.)

Accordingly, Applicant submits that Claim 29 is patentable over the cited art, and respectfully requests withdrawal of the rejection under 35 U.S.C. § 103(a). Independent Claims 34, 39, and 46 include features similar to those discussed above and therefore also are

believed to be patentable for at least the same reasons.

The other rejected claims in this application depend from one or another of the independent claims discussed above, and therefore are submitted to be patentable for at least the above reasons. Since each dependent claim is also deemed to define an additional aspect of the invention, individual reconsideration of the patentability of each claim on its own merits is respectfully requested.

The present Amendment After Final Action is believed clearly to place this application in condition for allowance. Therefore, its entry is believed proper under 37 C.F.R. § 1.116 and is respectfully requested, as an earnest effort to advance prosecution and reduce the number of issues. Should the Examiner believe that issues remain outstanding, it is respectfully requested that the Examiner contact Applicant's undersigned attorney in an effort to resolve such issues and advance the case to issue.

In view of the foregoing amendments and remarks, Applicant respectfully requests favorable reconsideration and early passage to issue of the present application.

No petition to extend the time for response to the Office Action is deemed necessary for the present Amendment. If, however, such a petition is required to make this Amendment timely filed, then this paper should be considered such a petition and the Commissioner is authorized to charge the requisite petition fee to Deposit Account 06-1205.

CONCLUSION

Applicant's undersigned attorney may be reached in our New York Office by telephone at (212) 218-2100. All correspondence should continue to be directed to our address listed below.

Respectfully submitted,



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